

REMARKS

Claims 8-13 are new. Support for the new claims may be found, for example, on specification pages 14, 15, 18, and 19.

Claims 1-13 remain pending in the application.

Responsive to the preliminary determination of lack of unity set forth in the outstanding Official Action, applicant hereby provisionally elects Group I, claim 1, directed to an agent for promoting osteogenesis and/or inhibiting bone resorption, with traverse. New claims 8-13 are directed to the provisionally elected invention.

Responsive to the election of species requirement, applicant hereby provisionally elects plasminogen, with traverse. Claims 1 and 8-13 are readable on the elected species.

The lack of unity determination set forth in the outstanding Official Action is improper.

Determination of the lack of unity is possible only when the claims of a different group lack a "special technical feature" relative to another. It is the burden of the Patent Office to establish the lack of any special technical feature, which the outstanding Official Action does not do.

In the present case, Claim 1 is directed to an agent for promoting osteogenesis and/or inhibiting bone resorption, and claims 2-7 are related to agents, food, drinks, drugs or feed that either promote osteogenesis or inhibit bone resorption.

Thus, the claims share the special technical features of promoting osteogenesis and/or inhibiting bone resorption.

The Examiner's attention in this regard is respectfully directed to PCT Rule 13.2 and Part 1(b) of Annex B of the Administrative Instructions under the PCT, which specify that "special technical features" is defined as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art. Therefore, absent any showing that the special technical features of claim 1 are shared by all of the claims, are present in a prior art reference, no determination as to lack of unity could properly be made.

Moreover, in applying the same legal standard with similar claims, the International Search Authority did not determine the unity of invention as lacking. Thus, the Patent Office has the benefit of the search report, but fails to explain why a different legal conclusion was reached.

Regarding the election of species requirement, the species of the present invention are directed to subject matter in which a search and examination may be completed within a narrow discipline. The species are directed to active ingredients for promoting osteogenesis and/or inhibiting bone resorption. Thus, it is respectfully submitted that individual species of claim 1 are sufficiently closely related that a full

search for one agent for promoting osteogenesis and/or inhibiting bone resorption would yield all prior art relevant to each other.

In view of the above, it is believed that the applicants are entitled to an action on the merits of all pending claims, in their full scope, in the present application. Such an action is accordingly respectfully requested.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

YOUNG & THOMPSON



Robert A. Madsen, Reg. No. 58,543
745 South 23rd Street
Arlington, VA 22202
Telephone (703) 521-2297
Telefax (703) 685-0573
(703) 979-4709

RM/mjr